

Application No. 09/683,237

REMARKS

The FINAL Office Action of October 6, 2003 has been carefully considered. Reconsideration of this application in view of the following remarks is respectfully requested. Claims 1-17 and 21-23 are pending in this application. Of these, claims 1, 8, and 21 are independent claims.

A response to a restriction requirement faxed February 14, 2003 elected claims 1-17, thereby withdrawing claims 18-20 from consideration in this Application. Applicant therefore retains the right to present claims 18-20 in a divisional application. An amendment faxed July 17, 2003 amended claims 1, 3, 5-8, 10-11, and 13 and added new claims 21-23.

1. Response to Rejection Under 35 USC 103

The Office Action on page 2, section 4, rejects claims 1-2, 4-12, 14, 16-21 and 23 under 35 USC 103(a) as being unpatentable over Combs, U.S. Patent No. 6,138,129 in view of Schwartz et al., U.S. Patent No. 5,905,988 (hereinafter referred to as "Schwartz").

Combs discloses a method and apparatus that provides search and link operations to be performed within and between one or more documents. The method involves extracting and storing text and corresponding location/context information in a pattern dictionary data structure to search for and link content within or between documents. A search/link tag is defined to serve as a label for a set of parameters and associated set of rules that are used to perform searching and linking of characteristic hit patterns identified within or between documents. (See summary of the invention and columns 3-6 of Combs.)

Generally, Schwartz discloses a method and apparatus for arranging information taken from a large database into an organizational topology. More specifically, Schwartz discloses a method and apparatus for transforming information obtained from a database into a presentation network topology for seamless serial presentation of selected data items to a user. The presentation network topology is a multidimensional network synthesized according to a predetermined set of rules that is constructed to allow for adaptive playback. (See summary and abstract of Schwartz.)

Application No. 09/683,237

In contrast, Applicant's claimed invention concerns a system, and method therefor, for *authoring* a document using a document editor and a directed search service. The directed search service is used while authoring the document with the document editor to specify a directed search having parameters that define a service request. In addition, Applicant's claimed invention provides that a meta-document server performs the directed search and the results therefrom are stored in the authored document as specified in the parameters of the service request. (See Applicant's specification paragraphs 502-513 and Figures 4, 52, and 53.)

The Office Action alleges on page 3, line 3 that Combs discloses the use of a document editor at "102, 104, fig. 1, col. 2, lines 45-64". More particularly, the Office Action alleges on page 3, lines 3-5 that the "disclosed system of Combs is a electronic document [editor for converting] to HTML format or SGML format". Applicant respectfully disagrees because the cited sections (namely step 104 in Figure 1 and the discussion in column 2 at lines 54-63) instead concerns the scanning of an electronic document and its conversion into a "desirable format" since linking between or within a scanned documents requires further processing to identify text for matching characteristic hit patterns.

Further the Office Action alleges on page 3, lines 6-7 that Combs discloses the *specification of a directed search while a document is authored* as claimed by Applicant because Combs discloses the specification of a "search/link tag by [a] user, [at] col. 3, lines 45-67 to col. 4, lines 1-7". Applicant respectfully disagrees and submits that the search/link tag disclosed by Combs whether or not specified by a user fails to disclose or suggest a directed search with information provider parameters as claimed by Applicant because the search/link tag disclosed in Combs is used to specify "character hit patterns" that are detected in both the source and target documents to perform inter-document cross-linking. (See columns 3 and 4 of Combs.)

Moreover, Combs discloses that when the character hit pattern of the source search/link tag and character hit pattern of the target search/link tag match exactly, links may be drawn between the documents, and in this way Combs links terms within a document (e.g., table of contents to other parts of document) and between documents (e.g., manuals). (See columns 5 and 6 of Combs.) Combs thus fails to disclose or suggest inserting a directed search (e.g., a *marker for the insertion of*

Application No. 09/683,237

data in a document identified at specified information providers) that is interpreted by a meta-document server to perform (i) the directed search and (ii) insert the search results in the document (e.g., in place of or at the marker) as claimed by Applicant.

In addition, the Office Action submits on page 4, lines 5-7 that "Combs does not explicitly disclose the information provider parameters identifying one or more information providers". The reason Combs fails to disclose information providers is that, as noted above, Combs concerns the cross-linking of character hit patterns in source and target documents. That is, while Combs discloses how to cross-link or hyperlink similar data, Applicant's claimed invention *concerns the addition of data to a document while it is authored through the specification and insertion of a directed search in the document as a document service request*.

The Office Action on page 4, lines 7-10 combines Combs with Schwartz and submits that because Schwartz teaches that "search parameters are accepted and [a] search engine [is selected], see (col. 14, lines 20-54), [Schwartz] teaches that a user can [specify] a parameter for a search engine (information provider) for performing searching and providing search results". However, the method and apparatus for transforming information obtained from a database into a presentation network disclosed by Schwartz (including the sections cited in the office action) fails to disclose or suggest the *specification* and the *insertion* of a directed search (which includes search criteria that identify information providers to perform the directed search and results parameters that specify a form in which the search results are to be inserted into the document) *into a document being authored using a document editor* as claimed by Applicant.

Accordingly, Applicant respectfully submits that independent claims 1, 8, and 21 are patentably distinguishable over Combs taken singly or in combination with Schwartz because they fail to disclose or suggest as claimed by Applicant the *specification of a directed search while a document is authored* and that the directed search is *inserted (i.e., embedded) in the document being authored*, where the directed search includes search criteria that identify information providers to perform the directed search and results parameters that specify a form in which the search results are to be inserted into the document.

Insofar as claims 2, 4-7, 9-12, 14, 16-20 and 23 are concerned, these claims

Application No. 09/683,237

depend from one of now presumably allowable independent claims 1, 8, and 21 and are also believed to be in allowable condition.

Reconsideration and withdrawal of the rejection on page 6, section 6 in the Office Action of claims 3, 13, and 22 under 35 U.S.C 103 based on Combs in view of Schwartz and in view of Sieffert et al., U.S. Patent No. 6,594,662 is also respectfully requested. There is no need to specifically address the merits of the claims 3, 13, and 22 because they depends from one of claims 1, 8, and 21 which are presumably patentable for the reasons set forth above.

2. Allowable Claim

Section 7 on page 7 of the Office Action indicates that claim 15 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. The undersigned appreciates this indication of allowable subject matter.


3. Fee Authorization And Extension Of Time

No additional fee is believed to be required for this amendment or response, however, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

4. Conclusion

In view of the foregoing remarks, reconsideration of this application and allowance thereof are earnestly solicited. In the event the Examiner considers a personal contact advantageous to the disposition of this case, the Examiner is hereby requested to call Attorney for Applicant(s), Thomas Zell.

Respectfully submitted,



Thomas Zell
Attorney for Applicant(s)
Registration No. 37,481
Telephone: 650-812-4282
Date: 11/3/03